



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,864	06/28/2001	Keiichi Yokoyama	209524US0 CONT	3226
22850	7590	10/16/2003	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.			PATTERSON, CHARLES L JR	
1940 DUKE STREET			ART UNIT	
ALEXANDRIA, VA 22314			PAPER NUMBER	

1652

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/892,864

Applicant(s)

YOKOYAMA ET AL.

Examiner

Charles L. Patterson, Jr.

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_


3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1-38, 41-43, 72, 73 and 75-86.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

  
Charles L. Patterson, Jr.  
Primary Examiner  
Art Unit: 1652

Continuation of 3. Applicant's reply has overcome the following rejection(s): 112 second paragraph, art rejection over Kawai, et al, 112 first paragraph rejection of claim 75..

Continuation of 5. does NOT place the application in condition for allowance because: Applicants refer to a recitation on page 303, column 1. The examiner has read this column 4 times and cannot find this recitation. As applicants state on page 10, the page number and line number should be given. Therefore, the previous characterizations of Ejima, et al. are incorporated here. Applicants then argue that because the reference teaches the solubilization and purification of hIL-6 and not transglutaminase, the rejection is not tenable and should be dropped. The rejection was a 103 rejection, not a 102 rejection and since the reference teaches that biological activity of hIL-6 was restored after the claimed treatment, one of ordinary skill in the art would also deduce that there would be at least a reasonable expectation that the activity of the transglutaminase would also be restored, absent unexpected results. A reasonable expectation of success is all that is required for obviousness under 103. The expectation would be a general one in view of all of the teachings and not a specific implicit teaching, and therefore it is maintained that the office has met its burden to provide a prima facie case. In applicants' reply to the 112 first paragraph, they again state that pages 10-12 teach the invention within the broad limits of the instant claims and therefore they have met their burden under 112 first paragraph of how to make the invention. The claims are drawn to many variables, i.e. "acidic aqueous medium", diluting 5 to 400 fold, a "neutral pH". Therefore any number of buffers could be used to adjust the pH to a wide range of pHs within the scope of the claims and the dilution could be anywhere within a 80 fold range. There are too many variables for one of ordinary skill in the art to know which combination would be operative without further guidance. This guidance is provided in the referenced examples. Therefore the rejection is maintained. The first paragraph rejection of claim 75 at the bottom of page 3 is dropped.